



**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

Serial No. : 09/925,673  
Applicant(s): Masakatsu KANEKO et al.  
Filed : August 9, 2001  
For : NOVEL NUCLEOSIDE AND  
OLIGONUCLEOTIDE ANALOGUES  
Art Unit : 1623  
Examiner : Shaojia A. Jiang  
Docket No. : 01376CIP/HG  
Customer No.: 01933  
Confirm No. : 4630

**INFORMATION DISCLOSURE STATEMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**MAIL STOP AMMENDMENT**

S I R :

Submitted concomitantly herewith are the following

- (1) a copy of WO 01/18015 (which was cited in copending application serial No. 10/430,705, which is the divisional application of the above-identified application); and
- (2) Form PTO/SB/08A.

The enclosed Form PTO/SB/08A lists USP 7,034,133 to Wengel et al.

USP 7,034,133 issued from U.S. application Serial No. 10/208,650. U.S. application Serial No. 10/208,650 was discussed

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*Dorothy DeFrancesco*

Dorothy DeFrancesco

In the event that this Paper is  
late filed, and the necessary  
petition for extension of time is  
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Petition for the requisite  
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in applicants' COMMENTS ON THE NOTICE OF ALLOWANCE AND THE CORRECTED NOTICE OF ALLOWANCE filed March 29, 2005 in the above-identified application serial No. 09/925,673.

The claims set forth in the published application of Serial No. 10/208,650 (namely US2003/0144231 A1) are different from the claims in USP 7,034,133.

The claims in USP 7,034,133 are printed from the AMENDMENT UNDER 37 CFR 1.132 filed on December 20, 2004 in Serial No. 10/208,65. A copy of said AMENDMENT UNDER 37 CFR 1.132 in Serial No. 10/208,650 was attached to applicants' COMMENTS ON THE NOTICE OF ALLOWANCE AND THE CORRECTION NOTICE OF ALLOWANCE filed on March 29, 2005 in the above-identified application Serial No. 09/925,673 and was also attached to applicants' EVIDENCE AND STATEMENT ACCOMPANYING PETITION TO RESET PERIOD FOR RESPONSE DUE TO POSTMARK DATE BEING ON MONTH LATER THAN MAIL DATE PRINTED ON PTO NOTICE OF ALLOWANCE filed March 18, 2005 in the above-identified application Serial No. 09/925,673. See particularly pages 3 and 4 of said EVIDENCE AND STATEMENT ACCOMPANYING PETITION TO RESET PERIOD FOR RESPONSE DUE TO POSTMARK DATE BEING LATER THAN THE MAIL DATE PRINTED ON PTO NOTICE OF ALLOWANCE wherein the following is stated:

"During the aforesaid telephone conversation with the Examiner, the non-receipt of an initialed copy of said Form PTO/SB/08A dated August 17, 2004 was called to the Examiner's attention. Although each of the four United States patent documents identified on said August 17, 2004 Form PTO/SB/08A is considered relevant, the patent document US 2003/0144231A1, which is the publication of SN 10/208,650 is particularly relevant in

view of the allowed claims which are different than the original claims printed in US 2003/0144231A1 and which are more relevant than the claims printed in US 2003/0144231A1."

The following is stated at the bottom of page 3 of said COMMENTS ON THE NOTICE OF ALLOWANCE AND THE CORRECTED NOTICE OF ALLOWANCE:

"There is considered to be an overlap between the claims in the above-identified application SN 09/925,673 (for example, claim 45) and the claims in said AMENDMENT UNDER 37 C.F.R. § 1.312 in SN 10/208,650 (for example, claim 180)."

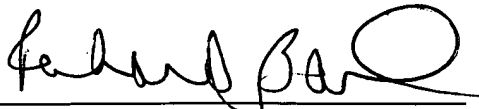
The claims in said AMENDMENT UNDER 37 CFR 1.312 in Serial No. 10/208,650 were first presented in application Serial No. 10/208,650 in a SUPPLEMENTAL PRELIMINARY AMENDMENT filed on January 12, 2004. All the originally presented claims were canceled in said SUPPLEMENTAL PRELIMINARY AMENDMENT filed on August 13, 2004.

It is respectfully submitted that the claims in USP 7,034,133 are not supported in the specification thereof, and therefore should have been rejected under 35 USC 112 first paragraph for lack of written description and lack of enablement

The Examiner is respectfully requested to return to the undersigned a copy of the enclosed Form PTO/SB/08A, with the

Examiner's initials in the left column next to the cited publications to indicate that the cited publications were considered and made of record.

Respectfully submitted,

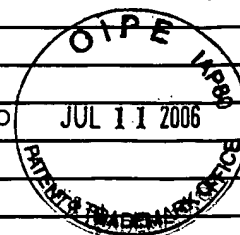
A handwritten signature in dark ink, appearing to read "Richard Barth", written over a horizontal line.

RICHARD S. BARTH  
REG. NO. 28,180

FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.  
220 Fifth Ave., 16<sup>th</sup> Floor  
New York, NY 1001-7708  
Tel. No.: (212) 319-4900  
Fax No.: (212) 319-5101  
E-Mail Address: BARTH@FHGC-LAW.COM  
RSB/rrb

Encs.: (1) copy of WO 01/18015  
(2) Form PTO/SB/08A

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				Application Number	09/925,673
				Filing Date	August 9, 2001
				First Named Inventor	Masakatsu KANEKO
				Group Art Unit	1623
				Examiner Name	Jiang
Sheet	1	of	1	Attorney Docket Number	01376CIP/HG



## U.S. PATENT DOCUMENTS

Exam. Inits*	Cite No <sup>1</sup>	Document Number	Kind Code <sup>2</sup>	Name of Patentee or Applicant	Publication Date MM-DD-YYYY	Relevant Portion
		7,034,133	B2	Wengel et al.	04-25-2006	

## FOREIGN PATENT DOCUMENTS

Exam Inits*	Cite No <sup>1</sup>	Office <sup>3</sup>	Document Number <sup>4</sup>	Kind Code <sup>5</sup>	Name of Patentee or Applicant	Publication Date MM-DD-YYYY	Relevant Portion	T <sup>6</sup>
		WO	01/18015	A1	Geron Corporation	3-15-2001		

Examiner Signature		Date Considered	
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\* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> See kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Mark here if English translation is attached.

DATE MAILED: July 11, 2006